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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,297	02/24/2004	Ronald J. Morrissey	004522-00027	2079

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BANNER & WITCOFF, LTD.
28 STATE STREET
28th FLOOR
BOSTON, MA 02109-9601

EXAMINER

WONG, EDNA

ART UNIT PAPER NUMBER

1753

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/785,297

Applicant(s)

MORRISSEY, RONALD J.

Examiner

Edna Wong

Art Unit

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005 and 04 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date July 13, 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This is in response to the Amendment dated September 22, 2005 and October 4, 2005. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Specification

The abstract of the disclosure was objected to because the word "said" is used in lines 1 and 3.

The objection of the abstract of the disclosure has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 112

Claims **4-6, 8-11, 15, 17, 20 and 22** have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 4-6, 8-11, 15, 17, 20 and 22 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 103

I. Claims **1-6** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 11-302893** ('893).

The rejection of claims 1-6 under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) is as applied in the Office Action dated June 23, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

Applicant states that in JP '893 (as well as Asakawa and Soutar), silver is added to the plating solution as a salt of silver with an inorganic or organic acid, usually the nitrate, and thus, thus, platable silver is formed *in situ*. This is in contrast to the solutions of the present application, wherein the silver complex is premanufactured separately and introduced in prefinished form.

In response, the electroplating solution disclosed by JP '893 is an aqueous solution of silver (page 3, [0024]). The platable silver disclosed by JP '893 would have been a product which reasonably appears to be identical with or only slightly different than the silver complex presently claimed. When the platable silver is formed *in situ* in the electroplating solution disclosed by JP '893, it becomes the silver-hydantoin complex and becomes the electroplating solution as presently claimed, which is the actual electroplating solution (the present invention is not a method of making an electroplating solution).

Applicant states that the claimed solution avoids the introduction of extraneous anions which are typically not be desirable in an electroplating bath.

In response, the claims as presently written uses the word "comprising" which leaves the claim open for the inclusion of unspecified ingredients even in major amounts

such as extraneous anions. MPEP § 2111.03.

Applicant states that JP '893 refers to hydantoins as chelators and Soutar claims multidentate ligands as complexing agents for silver. Silver exhibits only a valence of +1. It cannot form chelates, either with hydantoin or with polydentate complexing agents of the type indicated by Soutar.

In response, is Applicant saying that the silver and hydantoin compounds in the electroplating solution disclosed by JP '893 would not have formed a silver-hydantoin complex together?

Applicants state that the bath composition taught by JP '893 is overly complexed compared to the simple composition taught and claimed. The present invention reports a simple electroplating bath composition for the deposit of silver in a mirror-bright to brilliant form, without all of the components required by JP '893.

In response, the claims as presently written uses the word "comprising" which leaves the claim open for the inclusion of unspecified ingredients even in major amounts such as extraneous anions. MPEP § 2111.03.

II. Claims 7-11 have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 11-302893** ('893) as applied to claims 1-6 above, and further in view of **Soutar et al.** (US Patent No. 5,955,141).

The rejection of claims 7-11 under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) as applied to claims 1-6 above, and further in view of Soutar et al. is as applied in the Office Action dated June 23, 2005 and incorporated herein. The rejection has been maintained for the following reasons:

Applicant states that the arts disclosed in JP '893 and Soutar are incompatible.

In response, a prior art reference is analogous if the reference is in the field or applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned. MPEP § 2145(IX).

Soutar is reasonably pertinent to the particular problem with which JP '893 was concerned. That is, adjusting the pH so that a precipitate is not generated (see JP '893, page 6, [0045]). JP '893 teaches adjusting the pH using potassium hydroxide (page 10, [0063]), and Soutar teaches that potassium hydroxide and nitric acid as suitable buffering agents that not only adjusts the pH but also does not result in the precipitation out of solution of silver ions and/or complexing agent (col. 6, lines 34-49).

Applicant states that the proposed combination of JP '893 and Soutar is improper and it fails to support the obviousness rejection, which should be reconsidered and withdrawn.

In response, one having ordinary skill in the art is not substituting the hydantoin compounds disclosed by JP '893 with the multidentate ligand(s) disclosed by Soutar. One having ordinary skill in the art is simply substituting the potassium hydroxide

disclosed by JP '893 with the nitric acid disclosed by Soutar for the purpose of adjusting the pH of the plating solution without generating a precipitate. This would not be incompatible because a prior art reference is analogous if the reference is in the field or applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned. MPEP § 2145(IX).

Soutar is reasonably pertinent to the particular problem with which JP '893 was concerned. That is, adjusting the pH so that a precipitate is not generated (see JP '893, page 6, [0045]). JP '893 teaches adjusting the pH using potassium hydroxide (page 10, [0063]), and Soutar teaches that potassium hydroxide and nitric acid are suitable buffering agents that not only adjusts the pH but also does not result in the precipitation out of solution of silver ions and/or complexing agent (col. 6, lines 34-49).

III. Claims 12-17 have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 11-302893** ('893).

With regards to claim 17, the rejection under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) has been withdrawn in view of Applicant's amendment. Claim 17 has been cancelled.

With regards to claims 12-16, the rejection under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) is as applied in the Office Action dated June 23, 2005 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

IV. Claims **18-22** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 11-302893** ('893) as applied to claims 12-17 above, and further in view of **Soutar et al.** (US Patent No. 5,955,141).

With regards to claim 22, the rejection under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) as applied to claims 12-17 above, and further in view of Soutar et al. has been withdrawn in view of Applicant's amendment. Claim 22 has been cancelled.

With regards to claims 18-21, the rejection under 35 U.S.C. 103(a) as being unpatentable over JP 11-302893 ('893) as applied to claims 12-17 above, and further in view of Soutar et al. is as applied in the Office Action dated June 23, 2005 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

Response to Amendment

Claim Rejections - 35 USC § 112

Claims **1-16 and 18-21** are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1

lines 3-9, recites "(a) a premade aqueous solution of silver in the form of a complex of silver with hydantoin or a substituted hydantoin compound wherein said solution includes an excess molar ratio of the hydantoin or substituted hydantoin compound" and "(b) a premade aqueous solution of a conducting electrolyte comprising an effective quantity of a non-precipitating electrolyte salt and the hydantoin compound or a substituted hydantoin compound employed in part (a)".

Claim 12

lines 5-10, recites "(a) a premade aqueous solution of silver in the form of a complex of silver with hydantoin or a substituted hydantoin compound wherein said solution includes an excess molar ratio of the hydantoin or substituted hydantoin compound" and "(b) a premade aqueous solution of a conducting electrolyte comprising an effective quantity of a non-precipitating electrolyte salt and the hydantoin compound or a substituted hydantoin compound employed in part (a)".

Applicant's specification does not disclose these claim limitations. Therefore,

they are new matter.

II. Claims **1-16 and 18-21** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1

lines 8-9, it appears that “a substituted hydantoin compound” is the same as that recited in claim 1, lines 5-6. However, it is unclear if it is. If it is, then it is suggested that the word “a” be deleted.

Claim 4

lines 2-3, the words “(also known as - Cocoyl Sarcosine)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

line 3, the words “(also known as – Lauroyl Sarcosine)” is indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

line 4, the words “(also known as - Oleoyl Sarcosine)” is indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 4-5, the words “(also known as - the sodium salt of a sulfonated

naphthalene condensate)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 5-6, the words “(also known as - the sodium salt of a sulfonated naphthalene-formaldehyde condensate)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 6-7, the words “(also known as - the alkylamine salt of alkylbenzene sulfonic acid)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 7-8, the words “(also known as - the sodium salt of a sulfonated naphthalene-formaldehyde condensate)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

Claim 6

lines 2-3, the words “(also known as - Cocoyl Sarcosine)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

line 3, the words “(also known as - Lauroyl Sarcosine)” is indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

line 4, the words “(also known as - Oleoyl Sarcosine)” is indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 4-5, the words “(also known as - the sodium salt of a sulfonated naphthalene condensate)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 5-6, the words “(also known as - the sodium salt of a sulfonated naphthalene-formaldehyde condensate)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 6-7, the words “(also known as - the alkylamine salt of alkylbenzene sulfonic acid)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 7-8, the words “(also known as - the sodium salt of a sulfonated naphthalene-formaldehyde condensate)” are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

Claim 12

lines 9-10, it appears that “a substituted hydantoin compound” is the same as

that recited in claim 12, line 6. However, it is unclear if it is. If it is, then it is suggested that the word "a" be deleted.

Claim 15

lines 2-3, the words "(also known as - Cocoyl Sarcosine)" are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

line 3, the words "(also known as - Lauroyl Sarcosine)" is indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 3-4, the words "(also known as - Oleoyl Sarcosine)" is indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 4-5, the words "(also known as - the sodium salt of a sulfonated naphthalene condensate)" are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 5-6, the words "(also known as - the sodium salt of a sulfonated naphthalene-formaldehyde condensate)" are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 6-7, the words "(also known as - the alkylamine salt of alkylbenzene sulfonic acid)" are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

lines 7-8, the words "(also known as - the sodium salt of a sulfonated naphthalene-formaldehyde condensate)" are indefinite. It is unclear if the limitation in the parentheses is, in fact, a claim limitation.

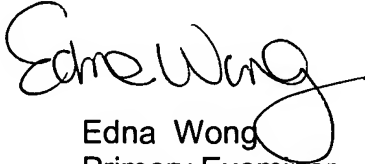
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Edna Wong
Primary Examiner
Art Unit 1753

EW
October 7, 2005